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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,068	06/14/2001	Markus Speidel	P21086	6444

7055 7590 09/16/2003

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

WILKINS III, HARRY D

ART UNIT PAPER NUMBER

1742

DATE MAILED: 09/16/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,068

Applicant(s)

SPEIDEL ET AL.

Examiner

Harry D Wilkins, III

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 17.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The rejection under 35 USC 103 based on Kato et al in view of Kudo et al has been withdrawn in view of Applicant's remarks regarding the content of Mn required in the alloy of Kato et al.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 8-20, 23, 27, 28, 30, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al (JP 57-210941).

These claims are rejected for the same reasons as stated in paragraph no. 3 of paper no. 15.

With respect to the amended feature of up to 0.60 wt% Mn, Kudo et al teach (see abstract) that the alloy contains less than 2.0 wt% Mn. It would have been within the expected skill of a routineer in the art to have optimized the content of Mn in the alloy of Kudo et al in order to maximize the mechanical and chemical properties of the alloy.

4. Claims 21, 22, 24-26, 29, 31, 32 and 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kudo et al (JP 57-210941) as applied to claims 8-20, 23, 27, 28, 30, 33 and 34 above, and further in view of Smith et al (US 6,287,398).

These claims are rejected for the same reasons as stated in paragraph no. 4 of paper no. 15.

Response to Arguments

5. Applicant's arguments filed 25 July 2003 have been fully considered but they are not persuasive. Applicant has argued that:

- a. Kudo does not require pressure metallurgy;
- b. Kudo does not disclose an example composition within the presently claimed range;
- c. There is no motivation to optimize the contents of the elements of Kudo to achieve the present invention;
- d. Kudo teach a B-free alloy;
- e. The references do not suggest the significantly improved creep strength and stabilization due to B being added;
- f. The amount of N present with limited Mn and Cr would not be able to be added without using special processing; and,
- g. The claim limitation of claim 33, that the composition "consists essentially of...", was not addressed in the rejection.

In response to Applicant's first argument, while it is true that Kudo does not teach using pressure metallurgy, this feature is not required by the present claim. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pressure metallurgy) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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In response to Applicant's second argument, this is the entire reason for the rejection not being under 35 USC 102. Had Kudo disclosed an example that was within the claimed range, it would have provided grounds for an anticipation rejection. In fact, the presently claimed ranges fall within the broad disclosure of Kudo, thus providing a basis for an obviousness rejection.

In response to Applicant's third argument, the motivation to optimize the elements of Kudo comes from the desire to achieve an alloy that is stronger and more resistant to corrosion.

In response to Applicant's fourth argument, while Kudo is silent with regards to B, Smith provides motivation to utilize B as a deoxidizer, thus improving the properties of the alloy by reducing the amount of O in the alloy.

In response to Applicant's fifth argument, while the reason for B being added is different from Applicant's reasons, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In response to Applicant's sixth argument, while it is true that Kudo does not teach using pressure metallurgy, this feature is not required by the present claim. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., pressure metallurgy) are not recited in the rejected claim(s). Although the claims are

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interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Applicant's seventh argument, the alloy of Kudo does not contain additional elements, therefore, there was no reason to address the presence of additional elements in this "consisting essentially of..." claim.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry D Wilkins, III whose telephone number is 703-305-9927. The examiner can normally be reached on M-Th 10:00am-8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy V King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

Harry D Wilkins, III
Examiner
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hdw

ROY KING
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700